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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/725,837 | 12/01/2003 | Tony Reid | 017622-000130US | 3216 |
| 20350 | 7590 | 03/12/2007 | EXAMINER | |
| TOWNSEND AND TOWNSEND AND CREW, LLP | | | THANH, QUANG D | |
| TWO EMBARCADERO CENTER | | | ART UNIT | PAPER NUMBER |
| EIGHTH FLOOR | | | 3771 | |
| SAN FRANCISCO, CA 94111-3834 | | | | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 03/12/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|----------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/725,837 | REID, TONY | |
| | Examiner Quang D. Thanh | Art Unit 3771 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 February 2007.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-10 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 2/16/07 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deasy, Jr. (5,171,211) in view of Myers (814,795).

Re claims 1, 5 and 10, Deasy discloses a system for applying pressure to a body limb, said system comprising: a first sleeve 18 configured to be slid over entire length of the arm from the shoulder to the wrist (fig. 7) and to apply an inward pressure onto the limb; a second sleeve 46 configured to be slid over substantially the entire length of the first sleeve (best seen in fig. 7) and to apply additional inward pressure along the

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length of the limb (col. 4, lines 35-45); except it is silent regarding the first sleeve having foam lining with ridges formed over an inner surface and the second sleeve being configured to be slid wholly over the entire length of the first sleeve. However, Myers teaches a system for applying pressure ("compressive covering" disclosed on line 9) to a body limb, said system comprising: a first innermost therapeutic pressure sleeve 1 (TPS) having a foam lining with ridges 3 formed over an inner surface, configured to be slid over the limb (figs. 1 and 3) and to apply an inward pressure onto the limb; a second sleeve 4 configured to be slid over the first sleeve and to apply additional inward pressure onto the limb; and a third sleeve 4 ("4 represents a series of outer encircling bands" as disclosed on lines 42-46) configured to be slid over the second sleeve and to apply additional inward pressure onto said limb (fig. 1 shows an inner sleeve 1 and two outer sleeves 4). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deasy, to include foam material for lining the inner surface of the first sleeve for the purpose of providing comfortable cushioning for the wearer during use, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and also specifically to include a foam lining with ridges formed over an inner surface, as taught and suggested by Myers, for the purpose of increasing the effectiveness of the compression therapy in the treatment of edema and providing improved the user's stamina (Deasy, col. 4, lines 60-66).

With respect to "the second sleeve being configured to be slid **wholly** over the entire length of the first sleeve" since Deasy already teaches that the second sleeve is configured to be slid over most of the length of the first sleeve (best seen in fig. 7),

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therefore it would have been an obvious matter of design choice to select the size of the second sleeve the same as the size of the first sleeve, for the purpose of covering the limb completely with both sleeves and thus enhancing the effectiveness of the compression therapy, and since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Re claims 2 and 6, Deasy discloses that the sleeve may be made of flexible relative heavy and strong elastic material (col. 3, lines 30-40), and therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made, to select a flexible material that also has a low friction characteristic to assist in removing the sleeve, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Furthermore, figs. I, 2A and 2B of the present application appear to illustrate the inner sleeve 18 and outer thin fabric compression sleeve 40 having the same length, with the outer sleeve being slid over the entire length of the inner sleeve. Fig. 6, in contrast, illustrates a different embodiment of the outer sleeve wherein a shortened sleeve 40a, identical in construction to sleeve 40 but of a shorter length than sleeve 18, can be used with sleeve 18 (present specification, p. 14). The present specification further discloses at page 14, that "a plurality of sleeves 40a, (which can be of various lengths equal or shorter than sleeve 18), can be applied one over another at various locations on sleeve 18." Therefore, absent a teaching as to criticality that the second

sleeve being configured to be slid *wholly* over the entire length of the first sleeve, this particular arrangement is deemed to have been known by those skilled in the art since the instant specification and evidence of record fail to attribute any significance (novel or unexpected results) to a particular arrangement. *In re Kuhle*, 526 F.2d 553,555,188 USPQ 7, 9 (CCPA 1975).

Re claims 4 and 9, Deasy taught that "each component part or portion of the garment is made of elastic material and is sized so as to be compressive on the body of the user" (col. 3, lines 46-48) for the purpose of reducing the symptoms of edema (col. 4, lines 65-66), and therefore depending on the size of the user and the limb the device is placed on, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to configure the Deasy' sleeve such that it would be capable of providing a wide range of radially inward pressure, including slight pressure or greater pressure in the range of 5 mmHg to 30mmHg.

Re claim 7, Myers further teaches a third sleeve 4 ("4 represents a series of outer encircling bands" as disclosed on lines 42-46) configured to be slid over the second sleeve and to apply additional inward pressure onto the limb (fig.1 shows an inner sleeve 1 and two outer sleeves 4).

Re claims 3 and 8, Myers' second and third sleeves 4 appear to be thin bands (fig. 1) and therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made, to select a flexible fabric material to make these outer sleeves, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

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Response to Arguments

Applicant's arguments filed on 2/16/07 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang D. Thanh whose telephone number is (571) 272-4982. The examiner can normally be reached on Monday-Thursday & alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The Central FAX phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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